

REMARKS

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action in light of the following remarks.

A telephone interview including the undersigned and the Examiner was conducted on November 10, 2005. The primary focus of the interview was upon the Examiner's objections to the drawings as set forth in the outstanding Office Action. Additionally, Applicant's position that the claimed invention is distinct over the cited art was briefly discussed as well. No formal agreement was reached with respect to either of the topics. The Examiner did, however, indicate he would reconsider his position regarding the drawing objections upon receipt of this Amendment.

Claims 13, 19, and 27 are independent claims; the remaining being dependent claims. In the outstanding Office Action, dated September 21, 2005, claims 13-26 were rejected. Specifically, the drawings are objected to as failing to show every feature of the invention specified in the claims. Claims 13-26 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 18, 20, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 13-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, U.S. Patent No. 4,561,575, alone, or in view of Lawrence, U.S. Patent No. 1,472,983, or alternatively in further view of either Japanese Patent 258755 or 315351. Claims 13, 14,

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18-22, 25-27 stand rejected under 35 U.S.C. 103(a) as unpatentable over either Jones or Lawrence in view of JP 295266. Claims 13-26 stand rejected in over any one of Jones, Lawrence, and/or Jozefczak, U.S. Patent No. 5186371, in view of Hansen, or alternatively over Hansen in view of any one of Jones, Lawrence, or Jozefczak. Finally, claims 13-26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Mrozowski et al., U.S. Patent No. 5183192, or over Mrozowski et al. in view of Hansen.

Currently, Claims 13-20 have been amended, Claims 22-26 have been canceled, and Claims 27-37, which are directed toward further novel aspects of the present invention, have been added. (Claim 27 is independent while Claims 28-37 are dependent). Claims 13 and 19 have been amended so that the claims now recite, *inter alia*, movement about a horizontal axis rather than movement through a plurality of positions about a horizontal axis. Claims 13 and 20 have been amended to include, enabling tire rotation to be performed at any of the positions. Claims 14-18 have been amended to include the language "[w]herein said material is circular... ." Claim 20 has, also, been amended to recite "pivot" arm rather than "swing" arm. The Applicant intends no change in the scope of the claims by the changes made by these amendments. Also, these amendments are not in acquiescence of the Office's position on allowability, but instead made merely to expedite prosecution. Please additionally note, the Remarks section provided in the Applicant's prior Amendment, dated June 27, 2005, remain equally applicable to the presently amended claims; therefore, the section is hereby incorporated by reference as if fully set forth herein.

Objections to the Drawings under 37 CFR 1.83(a)

The Examiner has objected to the drawings under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, "[t]he movement about the horizontal axis (cl. 13), the material extending past the lug (cl. 1), the specificities of the extent of the material about 240 degrees and 360 degrees (cl. 14-17, 22-25), the movement of the tire above the ground and the tire contracting the ground, the support of at least a major portion must be shown or the feature(s) canceled from the claims." (Office Action Page 2) Furthermore, the Examiner indicates "[i]t seems that the device in Fig. 3 is inoperative because it seems that portion 130 is connected to the front side of portion 100. Wouldn't the present of wheel interfere the movement of portion 130." (Id.) The Applicant respectfully submits all of the features of the invention as presently claimed are shown in the drawings and, therefore, the Applicant asks that the objection be withdrawn at this time.

The Applicant would first like to note, it is manifestly unfair to raise an objection to the present drawings at this late date. Generally, the OIPE and the Examiner upon his/her initial review of the Application will ensure that the requirements of 35 U.S.C. 113 have been met and where they have not the appropriate action should be taken, which may include the denial of a filing date by the OIPE or the entry of an objection by the Examiner. (See MPEP 608.02) However, in this instance where an objection is made to drawings that have already been through the examination process of the OIPE, passed through the process of examination, publication, and patent issuance in the parent patent,

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and were used during the present examination of this application through at least two Office Actions it is inappropriate to now raise such an objection.

As indicated above, however, the Applicant submits the drawings do show the elements of the invention as presently claimed. Movement about a horizontal axis is shown in the Figures. Figure 3 shows the pivot arm 130 to which the tire spinner 170 is attached in a lowered position and a pivot point 140 about which the pivot arm can travel, while Figure 5 shows the tire spinner in a raised position. Thus, the movement of travel is full appreciated and disclosed in the drawings and additionally in the Applicant's disclosure. The material extending past the lug is shown in Figures 3 and 5 as the tire spinner 170. The circular nature and extent of the material is also demonstrated in the tire spinner 170 as shown in Figures 3 and 5. The movement of the tire above ground and contacting the ground is demonstrated for the same reasons as is the movement about the horizontal axis set forth above. "Support of" the tire is shown in Figure 5, in which the tire is supported in the upright position, and in Figure 3, in which the tire is supported in the lowered position.

Regarding the Examiner's inoperability concern that the movement of pivot arm 130 might be impaired by the tire as shown in Figure 3, the Applicant submits the movement is not impaired. As shown in Figure 3, the tire 220 is in front of the pivot arm 130, thus, when the pivot arm moves upward about the horizontal axis the tire remains in front of both pivot arm 130 and swing arm 100. The movement of pivot arm 130 about a horizontal axis adjacent to the swing arm 100, as shown in Figure 3, can be analogized,

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for purposes of illustration, to that of the movement of scissors' blades. Therefore, no interference occurs between the tire and the swing arm during movement.

For all of the aforementioned reasons the Applicant respectfully requests the present objections to the drawings be withdrawn at this juncture.

35 U.S.C. 112, First Paragraph, Rejection

Claims 13-26 are rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement, because "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (Office Action Page 3) Examiner explains that it is unclear about which axis the movement claimed is occurring. The present invention comprises two arms, a swing arm and a pivot arm, each of which are capable of movement about an axis. The swing arm can move about a vertical axis and the pivot arm can move about a horizontal axis. In Figure 3, the swing arm 100 is in an open position forming an approximately 90 degree angle with the vehicles bumper 70. This movement is about a vertical axis. Also in Figure 3 the pivot arm 130 is in the lowered/open position in which it forms an angle of about 90 degrees with the swing arm 100. This movement is about a horizontal axis. Ultimately, therefore, the tire spinner 170 is capable of movement about both vertical and horizontal axes. Therefore, the Applicant respectfully requests withdrawal of the rejection.

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The Examiner also indicates Claims 14-17 and 22-25 are rejected because “[t]he specification fails to show the specificities of the extent about 240-360 degrees” and because “[t]he original disclosure does not teach the material support a major portion of the interior opening.” (Office Action Page 3)

The Applicant’s specification provides an extensive discussion of the tire spinner at Page 14, line 6 through Page 15, line 7. In this discussion it is indicated that the tire spinner is material extending out from the tire support such that a tire can be supported while the rim of the tire is aligned with the lug nuts. Furthermore, “[t]ire spinner 170 is circular in nature and is solid for approximately two-thirds of a circle. This is a design choice which uses less material. The important consideration is for tire spinner 170 to extend far enough around in circumference to meaningfully connect with the interior opening in the rim of tire 220... . Indeed, there is no reason why tire spinner 170 could not have an unbroken circumference.” (Page 14, line 18 - Page 15, line 4) Applicant suggests this section fully complies with the requirements of section 112 because one skilled in the art would fully appreciate the inventor’s possession of the invention at the time of the application. The section also discloses, in at least one embodiment of the invention, a tire spinner meaningfully connecting with a tire’s rim.

For the above reasons, Applicant submits the invention has been fully described in such a manner so as to completely meet the requirements of the statute and, therefore, the withdrawal of the rejection is requested.

35 U.S.C. 112, Second Paragraph, Rejections

Claims 18, 20, and 26 stand rejected under 35 U.S.C. 112, second paragraph, because "extent to meaningfully connect" is said to be indefinite. Applicant's previous remarks in its Amendment dated June 27, 2005 are applicable to the instant rejection. In those remarks the Applicant explained:

In the Applicant's Description of the Preferred Embodiments it is stated, *inter alia*:

As shown, tire spinner 170 is circular in nature and is solid for approximately two-thirds of a circle. This is a design choice which uses less material. The important consideration is for the tire spinner 170 to extend far enough around in circumference to meaningfully connect with the interior opening in the rim of the tire 220 when pivot arm 130 is in the lowered position. Indeed, there is no reason why tire spinner 170 could not have an unbroken circumference.

(Page 14, line 18 - Page 15, line 4) From this statement it is clear that the material of the tire spinner must be extent so as to be capable of a meaningful connection. The connection is meaningful if it "[p]ermits [a] tire 220 to be supported while the rim of [the] tire 220 is aligned with lug nuts 160." (Page 14, lines 9-10) It naturally follows that the connection would not be meaningful if it failed to provide support such that the invention could not be performed, i.e., the tire could not be supported while it was aligned. A circumference of two-thirds (or 240 degrees) is expressly given as one possible embodiment, as is any circumference of up to and including 360 degrees; all of which are embodiments within the application's use of meaningful connection.

* * *

Cancelled Claim 10 was rejected under § 112, second paragraph, because the term "meaningfully connect" was said to be indefinite. Claims 18 and 26 recite this language in the current amended claims. "In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph, by providing clear warning to others as to what constitutes infringement of

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the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished)" MPEP § 2173.02 (2005). As was discussed above, meaningfully connect does have a meaning to one skilled in the art in light of the whole claim to a tire spinner of which it is a part. The term must encompass tire support such that a tire can be aligned with the lug nuts.

(Applicant's Amendment, June 27, 2005, Pages 7-9) It is respectfully submitted that "meaningfully connect" as used in the present claims is not indefinite and that Applicant has particularly pointed out and distinctly claimed the subject matter which Applicant regards as its invention. The present rejection should therefore be withdrawn.

35 U.S.C. 102(b) and 103(a) Rejections

Claims 13-26 have been rejected in the outstanding Office Action as being anticipated by Mrozowski et al., US Patent No. 5183192. However, Mrozowski fails to disclose or even suggest all the elements of the present invention as claimed. As best understood, Mrozowski appears to be a spare tire carrier comprising "[a] primary rack and a secondary rack [that] are connected to each other and are independently rotateable about vertical and horizontal axes, respectively." (Abstract) The invention appears to support a tire using a "frusto-conical hub 28." This hub clearly fails to teach or suggest the present tire spinner, which is clearly not a frusto-conical hub. Furthermore, the frusto conical hub is not attached to a support arm but rather to a mounting box 30. Another difference between the inventions therefore exists. In any event, either one of these differences precludes the present anticipation rejection since "[a] claim is anticipated only if each and every element as set forth in the claim is found...". *E.g., Verdegaa Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As indicated above the remaining rejections appear to all be obviousness type rejections based on various combinations of the cited references. However, the Applicant respectfully traverses these rejections and asks the they be withdrawn for the reasons to follow.

As the Examiner is assuredly aware, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be: (1) a teaching or suggestion to one skilled in the art of all the claimed limitations of the invention to which the art is applied; (2) a suggestion or motivation to modify a reference or combine references; and (3) a reasonable expectation of success in making the modification or combination. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is clear that none of the cited art references, *per se*, teaches or suggests all of the elements of the presently claimed invention. Only through the combination of references might the elements disclosed in the prior art begin to approach meeting some of the present claims. However, as explained in the background of Applicant's disclosure, the present invention seeks to overcome the problems of aligning and securing a very large and heavy tire such as those used on HumVee vehicles to a tire support carrier, which is accomplished via the present tire spinner invention. A *prima facie* case of obviousness is lacking in this instance because, there is no motivation to combine the references where the references fail to be designed for very large and heavy tires. A primary motivation for the present tire spinner comes from the unique problem of aligning a heavy tire for being carried by a tire support. Without such a problem there can be no motivation to combine any references to meet the present invention as such would not be generally required to

overcome the problems addressed by the present references. Thus, withdrawal of the present obviousness type rejections is immediately proper for this reason alone.

Additionally, as noted above, the Applicant continues to submit that the combination of the cited references fails to teach all of the present elements of the invention as currently claimed. The Applicant would like to take this opportunity to address deficiencies in the art related to some elements as provided in the newly added claims. (It should be noted, however, that the Applicant in no way intends that by drawing the Examiner's attention to some of the elements which are not taught in the references that other elements are therefore thought to be taught.)

The newly added claims are directed to novel features of the present invention, including, broadly speaking, the ability to maintain any position through which the tire spinner can travel about a horizontal and/or vertical axis; a motorized means for movement about the axes; an electrical means for movement about the axes; and the tire spinner apparatus comprising a cable and winch. These and many other elements of the presently claimed invention are simply not taught or met by the cited references and, thus, the present rejections should be withdrawn and the claims allowed along with the newly added claims.

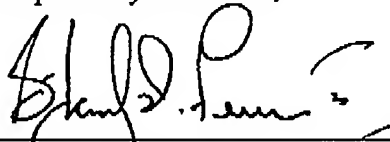
To briefly summarize, as indicated in the previous Amendment, the prior art cited against the present invention fails, *inter alia*, to teach or suggest an apparatus having a tire support capable of movement about both horizontal and vertical axes as does the present invention. Furthermore, none of the references cited lends itself to modification

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such that it would have been obvious for one skilled in the art to produce the presently claimed invention via a modification or combination of the prior art.

Therefore, it is respectfully submitted that the instant application, including Claims 13-21 and 27-37, is in condition for allowance. Notice to that effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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